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| APPLICATION NO.      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 10/076,583           | 02/15/2002  | Patric Enewoldsen    | Mo-6780/LeA 35,006  | 1272             |
| 157                  | 7590        | 10/07/2003           | EXAMINER            |                  |
| BAYER POLYMERS LLC   |             |                      | DICUS, TAMRA        |                  |
| 100 BAYER ROAD       |             |                      | ART UNIT            |                  |
| PITTSBURGH, PA 15205 |             |                      | PAPER NUMBER        |                  |
| 1774                 |             |                      |                     |                  |

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS7

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/076,583             | ENEWOLDSEN ET AL.   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Tamra L. Dicus         | 1774                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 July 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 3, and 5-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

The 112 rejection over claim 8 is withdrawn because of Applicant's agreement. Cancellation of claims 2 and 4 are acknowledged.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 9 provides for the use of the laminate of claim 1 but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.
4. Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,733,651 to Wank et al.

Wank teaches a laminate comprising a colored layer. The laminate comprises a translucent polyurethane (PU) layer above a polycarbonate substrate. Between the polyurethane and polycarbonate is a high-temperature resistant colored ink. See col. 2, lines 39-50, col. 8, lines 50-68, and Examples 1-4. Col. 9, lines 45-65 teaches the thermoplastic layers may be of various and different resins such as acrylonitrile/butadiene/styrene copolymer, PMMA, polystyrene, or cellulose ester, meeting the limitations of claims 3, 5, and 7. Regarding the properties softening temperature and hardness are inherent. The thickness of the PU layer is taught at col. 9, lines 40-45, meeting the range of at least 0.025 mm. Regarding claim 6, at col. 8, line 63, the colored ink layer is 3 to 50 microns, meeting the limitations.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,733,651 to Wank et al. in view of USPN 4,865,913 to Takeuchi et al.
5. Wank is relied upon for claim 1 as above. Wank does not teach a thermal transfer ink sheet having an intermediate layer of a different material. Takeuchi teaches a thermal transfer

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ink sheet having an intermediate layer (15) of adhesive between the substrate (2) of polymeric films or paper and the hot-melt ink layer (3). The adhesive layer is of acrylate, or polyacrylonitrile, polyester or other resins at col. 3, lines 25-57. The adhesive layer is used to hold the ink layer. Hence it would have been obvious to one of ordinary skill in the art to modify the laminate of Wank to include an intermediate layer that is of a different material, like the adhesive of Takeuchi to hold ink to a substrate as taught by Takeuchi in Comparative Example 3.

***Response to Arguments***

Applicant contests the 112/101 rejections over claim 9. The Applicant has not persuasively argued. No method steps have been introduced in the instant claim, which is why the 112 rejection withstands. The recitation “a method of using the laminate” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant alleges Wank does not teach polyurethane having the recited properties. The Applicant has not persuasively argued. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show an unobvious difference. The same material is provided. Polyurethane inherently provides a softening

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temperature and shore hardness value. The Applicant has not provided any objective evidence to the contrary.

Applicant alleges the structure of instant claim 1 is not provided by Wank. The Examiner does not agree. Wank teaches a laminate comprising a colored layer. The laminate comprises a translucent polyurethane (PU) layer above a polycarbonate substrate. Between the polyurethane and polycarbonate is a high-temperature resistant colored ink. See col. 2, lines 39-50, col. 8, lines 50-68, and Examples 1-4. Col. 9, lines 45-65 teaches the thermoplastic layers may be of various and different resins such as acrylonitrile/butadiene/styrene copolymer, PMMA, polystyrene, or cellulose ester, meeting the limitations of claims 3, 5, and 7. Regarding the properties softening temperature and hardness are inherent. The thickness of the PU layer is taught at col. 9, lines 40-45, meeting the range of at least 0.025 mm.

Applicant contends that Takeuchi teaches using the thermal transfer ink sheet for a thermal printer or typewriter and therefore is different from the instant application. The Applicant has not persuasively argued. Takeuchi teaches a thermal transfer ink sheet having an intermediate layer (15) of adhesive between the substrate (2) of polymeric films or paper and the hot-melt ink layer (3). The adhesive layer is of acrylate, or polyacrylonitrile, polyester or other resins at col. 3, lines 25-57.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

October 3, 2003

Tamra L. Dicus  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

